

Remarks:

Reconsideration of the application, as amended herein and in light of the remarks below, is respectfully requested. Claims 70-84 and 86-115 were pending as of the mailing of the Office Action to which this Amendment response¹. Claim 85 had been cancelled by the previous amendment. Claim 101 is amended herein to correct a clerical error.

I. Double Patenting.

The Office Action alleges that pending claims 72 and 102 of the instant application conflict with claim 103 of Application No. 10/918,967 ("the '967 application"). The Office Action further alleges that pending claim 84 conflicts with claim 119 of Application No. 09/941,682 ("the '682 application").

The characterization of conflicting claims relates to statutory double patenting under 35 U.S.C. § 121. Double patenting refers generally to an investigation of whether an invention is claimed twice and is determined "by analysis of the claims as a whole." General Foods Corp. v. Studiengesellschaft Kohle GmbH, 972 F.2d 1272 (Fed Cir. 1992).

No double patenting exists here because instant claims 72 and 103 relate to computerized prescription systems whereas claim 103 of the '967 application relates to a method for creating a prescription from a computerized system. Additionally, pending claim 84 is distinct from claim 119 of the '682 application because they have different scope and various differing elements.

Furthermore, and as detailed below, since the method claims of the '682 and '967 applications can be practiced with one or more materially different system(s), they do not conflict with the instant claims and, therefore, the double patenting rejections are improper. See MPEP § 806.05, 806.05(h)

A. Claims 72 and 102 of the instant application are not in conflict with claim 103 of the '967 application.

(i) Claim 72

Dependent claim 72 of the instant application relates to a computerized prescription system and depends from dependent claim 71. Claim 71, in turn, depends from independent claim 70, as follows:

¹ The Current Office Action states claims 70-115 are pending. Applicant respectfully points out that claim 85 was cancelled by the

70. A computerized prescription system, comprising: at least one user computer, said user computer having a graphical user interface for displaying and providing access to:

- (1) a plurality of patient records, each patient record including information about a patient's prescription history; and
- (2) information about pharmaceuticals correlated with medical conditions for which the pharmaceuticals are suitable for treating, said information derived from at least two of said plurality of patient records.

Claims 71 and 72 further limit the computerized prescription system set forth in claim 70.

Claim 103 of the '967 application differs from claim 72 in that it is a method claim. The method recited within claim 103 of the '967 application may be practiced using a materially different product (system). Additionally, claim 103 does not contain the limitation relating to a "plurality of patient records," as required by claim 72 of the subject application. Applicant asserts that the aforementioned unique limitations and scope of claim 72

previous amendment dated July 19, 2006.

of the instant application create the required clear line of demarcation to obviate the Double Patenting rejection.

(ii) Claim 102

Independent claim 102 of the instant application also relates to a computerized prescription system and requires a plurality of patient records and further requires "at least two" prescription histories.

In contrast, claim 103 of the '967 application is a method claim; furthermore, claim 103 does not require at least two prescription histories as set forth in claim 102 of the instant application. Thus, the method as claimed in claim 103 of the '967 application can be practiced with another materially different product. Applicant asserts that the aforementioned unique limitations and scope of claim 102 of the instant application create the required clear line of demarcation to obviate the Double Patenting rejection.

For at least the reasons set forth above, claims 72 and 102 of the instant application are not in conflict with claim 103 of the '967 application. Since no conflict exists between the distinct inventions set forth in

these claims, applicants respectfully traverse the double patenting rejection.

B. Claim 84 of the instant application is not in conflict with claim 119 of the '682 application.

Claim 84 of the subject application recites a computer implemented method of formatting an electronic prescription.

On the other hand, claim 119 of the '682 application relates to a method of using a system and provides for sorting records based on prescribed drugs approved by a drug benefits provider. The method of claim 119 of the '682 application can be practiced with another materially different product. For at least these reasons, applicant asserts a clear line of demarcation exists between claim 84 of the instant application and claim 119 of the '682 application. Since no conflict exists between the distinct inventions set forth in these claims, applicants respectfully traverse the double patenting rejection. Reconsideration and withdrawal of the double patenting rejection is requested.

II. REJECTIONS UNDER 35 U.S.C. 103(a)

Claims 70 - 77, 81 - 82, 84 - 86, 91 - 100, 102 - 107, 112 - 113 and 115 were rejected under 35 U.S.C. § 103(a) as allegedly being obvious over U.S. Patent No. 5,390,238 to Kirk et al ("**KIRK**") in view of the "Lunar Radiation Corp." ("**LUNAR**") article and further in view of U.S. Patent No. 6,317,719 to Schrier ("**SCHRIER**"). As the rejection (under § 103(a) set forth above) encompasses all pending independent claims, Applicant asserts that overcoming this rejection will enable all pending dependent claims to similarly be allowable. In response to the above-mentioned rejections, Applicant respectfully traverses the above rejections by demonstrating the following:

1. **SCHRIER** cannot be used to support an obviousness rejection because the subject invention was invented before the invention of **SCHRIER**. Because **SCHRIER** is used to support each of the rejections, the entire rejection set forth in item 4 of the Office Action must be withdrawn.

2. Assuming *arguendo* that **SCHRIER** is available as prior art, the combination of **KIRK** and **LUNAR** fails to render the subject invention obvious

3. **LUNAR** cannot be used to support an obviousness rejection due to a lack of enabling disclosure of the claims at issue.

A. SCHRIER CANNOT BE USED AS A REFERENCE TO SUPPORT AN OBVIOUSNESS REJECTION BECAUSE THE SUBJECT MATTER OF THE INSTANT APPLICATION WAS INVENTED BEFORE THE INVENTION OF SCHRIER

Applicant asserts that the cited **SCHRIER** reference is unavailable as prior art because the subject invention was invented before **SCHRIER**, which claims a priority to U.S. Patent Serial No. 08/167,286, filed December 13, 1993.

The Instant Application claims benefit to U.S. Patent Application Serial No. 08/330,745, filed Oct. 28, 1994. Applicant asserts conception and diligence extending before the December 13, 1993 priority date ("critical date") referred to above. In support thereof, Applicant submits herewith the following evidence:

1. Declaration under 37 C.F.R. § 1.131 of inventor Mayaud, with exhibits, to establish conception of the subject matter of the present claims prior to SCHRIER.
2. Analysis charts setting forth the location within the supporting material of each of the independent claims, claim element by claim element, with reference to page numbers (Exhibits are referenced by either POL or THB followed by a number).
3. A Declaration under 37 C.F.R. § 1.131 to support diligence of the inventor from a point in time prior to the critical date to the filing of the parent application in the present application.

Applicant has previously submitted congruous declarations under 37 C.F.R. § 1.131 to show conception and diligence towards reduction to practice from a date at least before December 13, 1993 in copending U.S. Patent Applications Serial Nos. 09/941,681, 09/941,682, and 09/201,107 (now U.S. Patent No. 7,072,840). In response thereto, the USPTO has accepted these declarations each time as establishing conception and

diligence towards reduction to practice in each of the
aforementioned '681 and '682 applications and '840
patent. The '681 and '682 applications, the '840 patent
and the instant application are each continuation
applications claiming benefit to the same priority date
of U.S. Patent Application Serial No. 08/330,745, filed
October 28, 1994.

The exhibits provided demonstrate the inventor possessed
the subject invention prior to at least December 13,
1993 and that the inventor Mayaud was diligent from a
point in time prior to the critical date to the filing
date of the parent of instant application.

The attached charts, labeled as "Claim Addendum," list
the elements of each of the independent claims in the
subject application and page designations where support
for each claim can be found in the Exhibits.

Also attached is a declaration from the Assignee
describing diligence from the conception prior to the
critical date until filing of the parent patent
application. This is supported by an analysis of
activity supported by notes in inventor Mayaud's daytime
planner. The declaration of the Assignee further sets

forth that inventor Mayaud is not cooperative in executing his declaration.²

Applicant asserts that the declarations and evidentiary material submitted herein, which have already been accepted twice by the USPTO in related cases to antedate **SCHRIER**, are sufficient in this case to establish the subject invention was invented before the invention of **SCHRIER** because the underlying facts attested to in the declaration of the subject application are the same as those submitted within the declarations during prosecution of the '681 application and the '840 patent.

For at least all of the facts set forth above and in light of the accompanying documents, **SCHRIER** is not available to be used as prior art against the pending claims. Thus, since each of the rejections under § 103(a) requires combination with **SCHRIER**, the rejections under 35 U.S.C. § 103(a) cannot properly stand. Applicant respectfully requests reconsideration of the rejection of claims 70 - 77, 81 - 82, 84 - 86, 91 - 100, 102 - 107, 112 - 113 and 115 under 35 U.S.C. § 103(a) and withdrawal of this rejection.

² In copending '681 application, the USPTO advised counsel that the Assignee should file a declaration for the non-cooperative inventor and sign the declaration on behalf of the inventor.

B. ASSUMING AGRUENDO THAT SCHRIER IS AVAILABLE AS
PRIOR ART, THE COMBINATION OF KIRK AND LUNAR
FAILS TO TEACH OR SUGGEST THE SUBJECT MATTER OF
THE PENDING CLAIMS

- (i) Pending claims 70, 84, 91, 96, 97, 99, 102 and 115 aggregate the data from multiple medical records and provide useful information derived from those records.

The inventions of present invention can be used to collect and use data from multiple records. For example, paragraphs [0107] - [0108] of the instant application state:

Of scientific note is that the system is privy to and operates at the confluence of three powerful emergent data streams: encyclopedic data on therapeutic agents intended to moderate particular conditions or patient problems; data on individual prescriber activity using skill and judgment to diagnose conditions or problems and make prescribing decisions selecting and applying therapeutic agents to diminish diagnosed conditions; and patient history data recording not only prescribing decisions but also the results of those decisions (see the description of FIG. 12, below). Thus, the system captures not only prescribing activity but also the prescriber's intent, the problem or condition targeted by the prescriber in specifying a particular drug, and can track the success of that intent. The linkage of treatment with condition treated captures the reason why the doctor took the prescribing action that was taken. This intent may, and can legally, be different from approved FDA therapeutic indications for a drug.

Of commercial note is that the foregoing data may be aggregated for multiple users, for

example by the host computing facility, for market research purposes. Also, an individual user's prescribing patterns may be reviewed by the user or by others. For example, drug benefits companies, can review the user's prescribing patterns for formulary compliance and respond by encouraging better compliance, where appropriate. Release of such data to third parties can be controlled to safeguard the privacy of the prescriber, or other health care provider, by prescriber-determined data access protocols specifying who, or what organization, department or group, may access what data, when they may access it and what they can do with it. For example, one physician may permit academic use for research studies and prohibit commercial use while another may permit either.

[Emphasis added] The benefits of providing aggregated data to third parties is additionally set forth, for example, in paragraph [0176], which states:

Pharmaceutical and managed care companies can gain marketing benefits from use of the system to introduce new drugs or new uses of old drugs to physicians, in a relevant manner, at a moment of peak interest.

[Emphasis added] And, paragraphs [0183] and [0184], which states, in part:

The historical drug-prescribed and condition-treated records obtainable by using the invention can provide a basis for condition-based treatment guidelines developed by drug formularies. This novel data provides a new vehicle for outcome research for managed care, leading to new approaches to cost-effective prescription treatments.

Compilation of an extensive or national database of (patient-anonymous) records providing a statistical historical listing of drugs prescribed versus associated conditions for which they were prescribed would be in the

public interest and of considerable value, so long as patient-confidentiality were maintained.

[Emphasis added] As such, Applicant's specification supports the use of prescription information from multiple records to derive information on drugs-prescribed correlated with conditions-treated.

Additionally, as stated in paragraph [0108] of the instant application, set forth above, the instant application supports the review of a plurality of records to determine prescribing practices of an individual prescriber. This is supported elsewhere in the instant application, for example, in paragraph [0165] of the instant application, which states, in part:

Review of a physician's prescribing record, detailing the various drugs selected to treat the different conditions exhibited by the patients encountered in the physician's daily practice, can reveal valuable information about the physician's prescribing practices and the degree to which they follow formulary guidelines.

[Emphasis added] As such, the instant application supports the aggregation of data from multiple records to determine such things as: the drugs prescribed correlated with the medical conditions for which the drugs are prescribed; and the prescribing practices of

an individual prescriber. The use of such aggregated data is claimed in several pending claims.

- (ii) Pending claims 70, 96 and 102 require, among other limitations, access to information about pharmaceuticals correlated with medical conditions for which the pharmaceuticals are suitable for treating, derived from at least two patient records.

Pending claim 70 recites, among other limitations:

at least one user computer, said user computer having a graphical user interface for displaying and providing access to:

- (1) a plurality of patient records, each patient record including information about a patient's prescription history; and
- (2) information about pharmaceuticals correlated with medical conditions for which the pharmaceuticals are suitable for treating, said information derived from at least two of said plurality of patient records.

[Emphasis added] Similarly, pending claim 96 recites, among other limitations:

b. a computer program stored on said memory medium, said computer program containing instructions for capturing prescription information and providing access to:

- (1) a plurality of patient records, each patient record including information about a patient's prescription history; and
- (2) information about pharmaceuticals correlated with medical conditions for which the pharmaceuticals are suitable for treating, said information derived from at

least two of said plurality of patient records.

[Emphasis added] And, Applicant's previously presented claim 102 recites, among other limitations:

at least one user computer, said user computer having a graphical user interface permitting capture of prescription information and providing access to all of:

(1) information about a plurality of prescription histories;

(2) information about pharmaceuticals correlated with the medical conditions for which the pharmaceuticals are suitable for treating, said information about pharmaceuticals being derived from at least two of said plurality of prescription histories; and

(3) information about the properties of pharmaceuticals;

[Emphasis added]

The KIRK and LUNAR references, taken alone or in combination, fail to teach the pharmaceuticals correlated with medical conditions for which the pharmaceuticals are suitable for treating, and the said information derived from at least two of said plurality of patient histories, as required by pending claims 70, 96 and 102. KIRK discloses a system whereby approval is obtained from a pharmacist and from a physician (col. 3, lines 35-39) Approval from the pharmacist and physician does not teach or suggest information about a

plurality of patient histories and information about pharmaceuticals correlated with patient conditions, as claimed in the subject application. Further, as stated on page 3 of the current Office Action, **KIRK** does not teach or suggest information about pharmaceuticals correlated with medical conditions for which the pharmaceuticals are used for treating. The Office Action further states on page 3, **LUNAR** by reciting the words "patient's medical history" does not disclose information about **pharmaceuticals correlated with medical conditions** for which the pharmaceuticals are suitable for treating. Likewise the limitation of **deriving information from at least two patient records** about pharmaceuticals correlated with medical conditions for which the pharmaceuticals are used for treating as claimed in the subject application is not disclosed by **LUNAR**.

As such, Applicant's claims 70, 96 and 102 are believed to be patentable over **KIRK** and **LUNAR**, taken alone or in combination.

- (iii) Pending claim 84 requires, among other limitations, sorting the received prescription information from at least two patient records to create a list of pharmaceuticals correlated with the medical conditions for which the pharmaceuticals were prescribed.

Pending claim 84 recites, in part:

sorting the received prescription information from at least two patient records to create a list of pharmaceuticals correlated with the medical conditions for which the pharmaceuticals were prescribed;

[Emphasis added] **KIRK** teaches a system for dispensing medication and receiving approval from a pharmacist and a physician. There is no mention of "sorting the received prescription information from at least two patient records to create a list of pharmaceuticals correlated with the medical conditions for which the pharmaceuticals were prescribed" as claimed in the subject application. **LUNAR** teaches "treatment programs" but does not elaborate or give any detail. **LUNAR** does not have any mention of "sorting the received prescription information from at least two patient records to create a list of pharmaceuticals correlated with the medical conditions for which the pharmaceuticals were prescribed" as claimed in the subject application. The **KIRK** and **LUNAR** references, taken alone or in combination, fail to teach or suggest among other limitations, sorting the received prescription information from at least two patient records to create a list of pharmaceuticals correlated with the medical conditions for which the

pharmaceuticals were prescribed, as required by pending claim 84.

- (iv) Pending claims 91 and 115 requires, among other limitations, a sorting device for sorting the information from at least two of said plurality of medical histories to produce a report correlating at least one individual prescriber with at least one therapeutic agent prescribed by said at least one individual prescriber and with said at least one medical condition for which said at least one therapeutic agent was prescribed by said at least one individual prescriber.

Pending claims 91 and 115 recite, in part:

a sorting device for sorting the information from at least two of said plurality of medical histories to produce a report correlating at least one individual prescriber with at least one therapeutic agent prescribed by said at least one individual prescriber and with said at least one medical condition for which said at least one therapeutic agent was prescribed by said at least one individual prescriber;

[Emphasis added]

KIRK is a health support system [that] provides support in part by dispensing medication in accordance with a predetermined schedule (col. 3, lines 3-5). **KIRK** has no teaching or suggestion for the sorting device of the claimed invention. **LUNAR** only recites the "patient medical history" and does not have any indication relating to the system having the sorting device of the claimed invention. The **KIRK** and **LUNAR** references, taken

alone or in combination, fail to teach or suggest among other limitations, **sorting the information from at least two medical histories** to produce a report correlating at least one individual prescriber with at least one therapeutic agent prescribed by the individual prescriber and at least one medical condition for which the therapeutic agent was prescribed, as required by Applicant's claims 91 and 115.

- (v) Pending claim 97 requires, among other limitations, sorting the received prescription information from at least two records to create a list of pharmaceuticals correlated with the medical conditions for which the pharmaceuticals were prescribed.

Pending amended claim 97 recites, among other limitations:

sorting the received prescription information from at least two records to create a list of pharmaceuticals correlated with the medical conditions for which the pharmaceuticals were prescribed.

[Emphasis added]

Based on the arguments and distinctions stated immediately above in sec II(B)(iv) the KIRK and LUNAR references, taken alone or in combination, fails to teach or suggest among other limitations, **sorting the received prescription information from at least two records to create a list of pharmaceuticals correlated**

with the medical conditions for which the
pharmaceuticals were prescribed, as required by
Applicant's claim 97.

- (vi) Applicant's claim 99 requires, among other limitations, sorting the received prescription information from at least two records to create a list of pharmaceuticals correlated with the medical conditions for which the pharmaceuticals were prescribed.

Applicant's amended claim 99 recites, among other limitations:

c. said computer program containing instructions for sorting the information from at least two of said plurality of medical histories to produce a report correlating at least one individual prescriber with at least one therapeutic agent prescribed by said at least one individual prescriber and with said at least one medical condition for which said at least one therapeutic agent was prescribed by said at least one individual prescriber, and for outputting said report.

[Emphasis added]

Based on the arguments and distinctions stated immediately above in sec II.(B)(iv) the KIRK and LUNAR references, taken alone or in combination, fails to teach or suggest among other limitations, instructions for sorting the information from at least two of said plurality of medical histories to produce a report correlating at least one individual prescriber with at

least one therapeutic agent prescribed by said at least one individual prescriber and with said at least one medical condition for which said at least one therapeutic agent was prescribed by said at least one individual prescriber, as required by Applicant's claim 99.

- (vii) The cited art does not teach or suggest "drug formulary information" as recited within claims 100 and 101.

Claims 100 and 101 recite, among other limitations:

- b) drug formulary information identifying at least one of multiple drugs as a patient's drug benefit provider's drug formulary preferences to ensure that the electronic prescription is filled with a benefit plan recommended drug;

[Emphasis added]

Neither **KIRK**, nor **LUNAR** teach or suggest the use of "drug formulary information" as claimed by Applicant in claims 100 and 101. **KIRK** neither teaches nor suggests drug formulary preferences.

The Office Action alleges, in part:

Furthermore, as per claim 100, "Lunar Radiation Corp." teaches a means of providing drug formulary preferences (of a patient's drug provider) to ensure that the electronic prescription is filled with a benefit plan recommend drug ("Lunar Radiation Corp.": Main Paragraph, Sentences 2 and 4). The motivation

for making this modification to the combined system of Kirk in view of "Lunar Radiation Corp." and Kehr was the same as that was set forth in the rejection of claim 70 above. (Note "Lunar Radiation Corp." teaches that database results are retrieved and displayed and this information includes patient information as well as therapy (drug) information. The examiner takes the position that drug formulary preferences is within the scope of therapy information. Furthermore, "Lunar Radiation Corp." states that the above stated information is provided to "ensure that the electronic prescription is filled with a benefit plan recommended drug" and the examiner takes the position that since the motivation of using the system of "Lunar Radiation Corp." is to provide users with more meaningful and efficient record management the above stated reason for ensuring that benefit plan recommended drugs are prescribed is to ensure that the prescription drug system functions more efficiently.

See Office Action, at 4-5. [Emphasis added] Applicant respectfully disagrees that the LUNAR reference discloses Applicant's claimed "drug formulary information". Nowhere does LUNAR teach or suggest "drug formulary information". In fact, the Office Action states "Lunar Radiation Corp." discloses that the above stated information is provided to "ensure that the electronic prescription is filled with a benefit plan recommended drug". However, nothing in LUNAR suggests using a benefit plan recommended drug. Rather, the citable prior art portion of LUNAR, as provided to Applicant with the Office Action, states in its entirety:

Lunar Radiation Corp. has introduced patient database software as a standard feature of its IBM-based DP3 and SP2 bone densitometers.

The patient data base is dBASE III compatible and allows retrieval of patient information to meet your needs. Scan results can be recalled chronologically to aid monitoring of therapy and to display disease process and patient progress. The database can also store information on a patient's medical history, fracture history, referring physician, treatment programs and changes, and insurance coverage. Data entry fields allow the input of additional patient information for more efficient and meaningful record management.

[Emphasis added]

LUNAR'S single paragraph disclosure recites the words "patient's medical history, fracture history, referring physician, treatment programs and changes and insurance coverage." These broad terms have no detail regarding selection of drugs based on "drug formulary information." The specification of the subject application, in paragraph [0039] describes the selection based on formulary requirements as follows:

System suggestions for condition-related drug selection may be further refined into categories such as relative cost, generic or brand name and so on. Where many drugs are available for treating a patient's active condition, one particularly useful presentation is by multiple lines of therapeutic preference according to drug formulary guidelines. Thus, within the patient's particular formulary there may be suggested first, second and third lines of therapy. Different suggestions may be made for different patients according to the

preferences of the patient's particular
drugs benefit management company.

The words "treatment programs" disclosed in **LUNAR** do not restrict treatment based on a patient's drug formulary's preferences as claimed in the present invention. As such, the disclosure of "treatment programs" in **LUNAR** would not teach or suggest Applicant's claimed "drug formulary information." Further, the insurance coverage of a patient relates to **by whom** the patient is insured, **and would not suggest to a person of skill in the art** "drug formulary information", as required by Applicant's claims 100 and 101.³

In the absence of **LUNAR** teaching or suggesting "drug formulary information" as claimed by Applicant, claims 100 and 101 are believed patentable over the combination of **KIRK** and **LUNAR**.

(viii) **The cited art does not teach or suggest a chronologically current version of the patient's prescription history "not being**

³ From the statements made in the Office Action, it is possible that a **different LUNAR** reference was provided to Applicant with the Office Action than is being reviewed by the Examiner. If the instant rejection is maintained, Applicant respectfully requests clarification of the location where in the reference the Examiner that **"Lunar Radiation Corp." states that the above stated information is provided to "ensure that the electronic prescription is filled with a benefit plan recommended drug", as stated on page 5 of the Office Action.**

**permanently stored" as recited within
claim 98.**

Pending claim 98 has been amended to recite, among other
limitations:

b. a computer program stored on said memory
medium, said computer program containing
instructions for interrogating databases
expected to contain information about a patient
based on a patient's relationship with the
provider of that database **and for assembling
patient information into a chronologically
current version of said patient's prescription
history, said chronologically current version of
said patient's prescription history being
displayed but not being permanently stored.**

[Emphasis added] Claim 98 is supported, for example,
paragraphs [0074] - [0079] and paragraphs [0124] -
[0126], which state:

The invention also provides novel data-retrieval
network systems to retrieve relevant patient
data elements from multiple remote heterogenous
primary source databases. Preferably, **every time**
a host computer facility receives a call from a
user device for a patient history or patient
record, **relevant data elements, for that record,
or a record component** (e.g. the most recent six-
month or twelve-month portion), **are retrieved
from remote source databases, dynamically
assembled, or integrated, into a virtual patient
record**, as described above, and delivered to the
user device as an integral system data set.
Alternatively, record assembly, which does not
require undue hardware resources, can be
performed on board the user device.

**The record is viewed and may be printed out by
the user, with patient authorization, but does
not need to be permanently stored.**

The host computer facility responsible for dynamic assembly of the virtual record logs the time, date and calling user to provide an audit trail of access to the patient's record, **but does not commit the record to permanent storage. After use, the virtual patient record disappears, although it can be reconstructed archivally.**

[Emphasis added]

Claim 98 recites a "virtual patient record" that is **chronologically current** and assembled **each** time it is requested, **and which is not permanently stored**, thus necessitating that the patient record is created anew each time it is requested.

This is neither taught nor suggested by **KIRK** or **LUNAR**. Rather, **KIRK** stores the patient's records permanently on the servers 38, including the financial data. See KIRK item 42 of Fig. 3; col. 3, lines 53 ("Operators 46, through monitoring terminal 44 and a communications link (preferably digital), can access data from local central servers 38, including financial data 42"). **LUNAR** discloses a patient database that allows retrieval of patient information. This is contrary to "assembling a chronologically current patient history that is not permanently stored" as claimed in the subject application.

Nothing in KIRK or LUNAR teaches or suggests assembling
a chronologically current patient history that is not
permanently stored. As such, Applicant's claim 98 is
believed to be patentable over KIRK and LUNAR, taken
alone, or in combination. Applicant respectfully
request reconsideration and withdrawal of this
rejection.

- (ix) Claims 78-80, 83, 87-90, 108-110, and 113
were improperly rejected under 35 U.S.C.
§ 103(a) as being unpatentable over Kirk
in view of U.S. Patent No. 5,774,879
(Custy).

Applicant respectfully traverses this rejection based on
the arguments and distinctions stated immediately above
in sec II.(B)(ii) where the Office Action stated the
deficiencies in KIRK) relating to the KIRK reference and
the fact that combination of KIRK with CUSTY against
Applicant's dependent claims fails to cure the above
established deficiencies of KIRK. Applicant
respectfully requests reconsideration and withdrawal of
this rejection.

- (x) Pending claim 101 was improperly rejected
under 35 U.S.C. 103(a) as being unpatentable
over KIRK in view of U.S. Patent No. 5,642,731
to KEHR.

Applicant respectfully traverses this rejection based on the arguments and distinctions stated immediately above in sec II.(B)(ii) where the Office Action stated the deficiencies in KIRK (relating to the **KIRK** reference where the Office Action stated the deficiencies in **KIRK**) KEHR teaches in col 6 line 65 - col. 7, line 7

The monitor allows for interaction with physicians or pharmacists, who can upload information into the device, or download information from the device. The data that is stored in the monitor, enumerated above, can be downloaded into a personal computer or printer. The personal computer can be programmed to analyze the data that is downloaded, and then upload information in response to the information that was downloaded. The uploaded information could include warnings to the patient regarding dangerous behavior patterns of medication taking that have been recorded by the device, or other instructions to the patient based upon analysis of patient noncompliance, partial compliance, or potential drug interactions. For example, if the patient forgets to take the medicine Digoxin for heart disease, the device might display "TO AVOID HEART FAILURE YOU MUST TAKE DIGOXIN ON TIME!"

KEHR is a medication dispensing system with a warning regarding "dangerous behavior patterns of medication taking." **KEHR** does not have any teaching or suggestion regarding "a drug contraindication review automatically activatable from the prescription fulfillment system prior to fulfillment" as claimed in the subject application.

Additionally, the combination of **KIRK** and **KEHR** fails to cure the above-established deficiencies of **KIRK** because as seen in the above excerpt from Kehr cited in the Office Action, **KEHR fails** to teach a drug contraindication review automatically activatable from the prescription fulfillment system prior to fulfillment, contrary to the statements within the Office Action.

Nothing in **KEHR** provides for a drug contraindication review automatically activatable from the prescription fulfillment system prior to fulfillment as set forth in the present claim. **KEHR** solely teaches a warning that may be issued after input of a medical record that is independent of the prescription process. The prescription can still be written and fulfilled prior to any physician upload of information as described in **KEHR**. Thus **KEHR** is deficient in its teaching. There is no motivation to combine with **KIRK** or modify **KEHR** to arrive at the prescription fulfillment software system as currently claimed. Applicant respectfully requests reconsideration and withdrawal of this rejection.

III. LUNAR CANNOT BE APPLIED TO SUPPORT AN OBVIOUSNESS REJECTION

Applicant further asserts that LUNAR is not available as a prior art reference. According to Elan Pharms. v. Mayo Found. for Med. Educ. & Research 346 F.3d 1051, 1054 (Fed. Cir. 2003), enablement requires that

the prior art reference must teach one of ordinary skill in the art to make or carry out the claimed invention without undue experimentation.

Elan further sets forth:

The disclosure in an assertedly anticipating reference must be adequate to enable possession of the desired subject matter. It is insufficient to name or describe the desired subject matter, if it cannot be produced without undue experimentation.

Id. at 1055. LUNAR is a news release from PR NEWSWIRE introducing a database incorporated into their bone densitometer. LUNAR recites: "The database (of the bone densitometer) can also store information on a patient's medical history, fracture history, referring physician, treatment programs and changes, and insurance coverage." Based on the standard set forth in Elan, the LUNAR reference cannot be used as a prior reference because LUNAR merely names certain features of the bone densitometer, but does not describe in any detail. Applicant asserts LUNAR does not have enabling

disclosure within the four corners of the document to demonstrate possession of the desired subject matter and whatever subject matter is disclosed in **LUNAR**, possession of the desired subject matter cannot be produced without undue experimentation. Because the **LUNAR** reference does not have the requisite adequate disclosure, it cannot be used as a reference in any of the rejections set forth in the Action.

IV. Conclusion.

As stated herein, **SCHRIER** is not available as a prior art reference to support the obviousness rejections cited in the current Office Action. Additionally, the pending claims are patentable over **KIRK and LUNAR**, whether taken alone or in combination. Furthermore, neither the **SCHRIER** nor the **KEHR** reference cited in the Office Action in combination with **KIRK and LUNAR** against the pending independent claims, nor the **CUSTY** reference, cited against various dependent claims, cure the above deficiencies of the **KIRK and LUNAR** references.

Accordingly, it is believed that none of the references, whether taken alone or in any combination, teach or suggest the features of claims 70, 84, 91, 96 - 102 and 115. Claims 70, 84, 91, 96 - 102 and 115 are,

therefore, believed to be patentable over the art. The dependent claims are believed to be patentable as well because they all are ultimately dependent on claims 70, 84, 91 or 102.

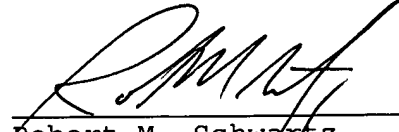
In view of the foregoing, reconsideration and allowance of claims 70 - 84 and 86 - 115 are solicited.

In the event the Examiner should still find any of the claims to be unpatentable, counsel would appreciate receiving a telephone call so that, if possible, patentable language can be worked out. In the alternative, the entry of the amendment is requested, as it is believed to place the application in better condition for appeal, without requiring extension of the field of search.

Please charge any fees that might be due with respect to Sections 1.16 and 1.17 to the Deposit Account of Robert M. Schwartz, P.A., No. 19-0734.

Respectfully submitted,

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